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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/596,992

Filing Date: July 05, 2006

Appellant(s): DUERNBERGER, GERHARD

Richard F. Bis
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 1/3/2012 appealing from the Office action mailed 5/26/2011.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 3-8 and 10-17.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being

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maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,505,452	HANNING	6-2003
2003/0024199	PERVAN	2-2003
7,065,935	EISERMANN	6-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 1. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanning (US 6,505,452).**

Regarding claim 1, Hanning discloses connecting means 42, 43 made in such a way that one said connecting means can be connected with the other connecting means in a positive fit in two directions that are perpendicular relative to each other, (Fig 8) and wherein said one and other connecting means are formed by respective panel edges 44, 45 that have the same geometry, and each panel edge has a uniform cross-sectional portion bounded by top (O) and bottom (V) surfaces of the panels and a profiled cross-sectional portion 47, 48 extending from the uniform cross-sectional portion, each profiled portion having the same geometry but inverted with respect to one another, (Fig 8), (Col 9, Lines 65-67, Col 10, Lines 1-4).

Regarding claim 3, Hanning discloses wherein the profiled cross-sectional portions 47, 48 are configured so that they can be connected by lowering the one connecting means 42 relative to the other connecting means 43 and then pushing the connecting means towards each other in a direction perpendicular relative to the lowering motion, (Fig 8), (Col 10, Lines 43-48).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanning (US 6,505,452) in view of Pervan (US 2003/0024199).

Regarding claims 4 and 17 , Hanning discloses connecting means according to claim 1, but does not disclose separate locking means inserted between the panel edges after the panel edges have been connected together for locking the panel edges in such connected state wherein the separate locking means is a securing pin. However, Pervan teaches connecting means having a separate locking means 52 inserted between the panel edges, wherein the separate locking means is a securing pin (Fig 14c), (par 179). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the connection means of Hanning to include a separate locking means as taught by Pervan in order to counteract changes in the properties of the floor panels caused by moisture (Abstract).

The limitation "after the panel edges have been connected together" is regarded to as functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP § 2114.

Regarding claim 5, as best understood, Hanning modified by Pervan discloses as disclosed in claim 4, but does not disclose the locking means is step-shaped or stair-shaped. However, it would have been an obvious matter of design choice to modify the locking means of Hanning and Pervan to have a step-shaped or stair-shaped, since such a modification would have involved a mere change in the shape of the component and would provide a locking means that would adjust to a step shaped space between the connecting means. A change in shape is generally recognized as being within the level of ordinary skill in the art.

Regarding claim 6, Hanning modified by Pervan discloses as disclosed in claim 1, Pervan further discloses connecting means having a separate locking means 52 that consists of a compressible material such as plastics, which can be pushed into a channel formed between the panel edge, (Fig 14c), (Par 71, 76).

Hanning discloses at least one external dimension of the panel edges 44, 45 is greater than the corresponding internal dimension of a channel 53, (Fig 8). The modified connecting means would have the separate locking means being held in the channel by press fit and the separate locking means.

Regarding claim 7, Hanning modified by Pervan discloses as disclosed in claim 1, Pervan further discloses connecting means which are formed in particular as laminate flooring panels comprising a base board and a decorative layer.(Paragraph 67). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the connection means of Hanning to be formed as laminate flooring including a base and a decorative layer as taught by Pervan in order to provide a moisture proof material and a decorative appearance.

3. Claims 8, 10, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanning (US 6,505,452) in view of Eisermann (US 7,065,935).

Regarding claims 8 and 16, Hanning discloses panels of rectangular shape having lateral connecting elements 42, 43 provided along lateral edges of the panels, which lateral connecting elements are configured to be connected with each other with a positive fit in two directions that are perpendicular relative to each other, (Fig 8) and

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longitudinal connecting elements provided along longitudinal edges of the panels (Fig 1); wherein said lateral connecting elements are formed by respective panel edges 44, 45 that have the same geometry, and each panel edge has a uniform cross-sectional portion bounded by top (O) and bottom (V) surfaces of the panels and a profiled cross-sectional portion 47, 48 extending from the uniform cross-sectional portion, each profiled portion having the same geometry but inverted with respect to one another, (Fig 8), (Col 9, Lines 65-67, Col 10, Lines 1-4).

Hanning does not disclose the longitudinal connecting elements are configured to be connected with each other by a turning motion. However, Eisermann teaches panels having longitudinal connecting elements are configured to be connected with each other by a turning motion (Fig 3, 4, 8). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the panels of Hanning to include connecting elements in the longitudinal direction as taught by Eisermann in order to simplify the method for laying and interlocking panels and to improve the durability of the fastening system.

Regarding claim 10, Hanning discloses wherein the lateral connecting elements 42, 43 are configured so that they can be connected by lowering the one connecting element 42 relative to the other connecting element 43 and then pushing the connecting element towards each other in a direction perpendicular relative to the lowering motion, (Fig 8), (Col 10, Lines 43-48).

Regarding claim 13, Hanning discloses wherein the lateral connecting elements 42, 43 are step-shaped (Fig 8).

4. Claims 11, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanning (US 6,505,452) in view of Eisermann (US 7,065,935) and further in view of Pervan (US 2003/0024199).

Regarding claim 11, Hanning modified by Eisermann discloses as discussed in claim 8, but does not disclose a locking device insertable into a space between the lateral connecting elements when coupled together to lock the lateral connecting elements against separation. However, Pervan discloses a locking device 52 insertable into a space between the lateral connecting elements when coupled together to lock the lateral connecting elements against separation, (Fig 14c), (Par 71, 76). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the connecting elements of Hanning to include a locking device as taught by Pervan in order to counteract changes in the properties of the floor panels caused by moisture (Abstract). The modified panels would have the lateral connecting elements locked against separation when coupled together.

Regarding claim 12, Hanning modified by Eisermann discloses as discussed in claim 12, Pervan further discloses the locking device has a substantially rectangular cross-section (Fig 14c), (Par 179).

Regarding claim 14, Hanning modified by Eisermann discloses as discussed in claim 8, but does not disclose a separate locking device that can be pushed into a channel formed by the lateral connecting elements when coupled together, wherein at least one external dimension of the lateral connecting elements is greater than the

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corresponding internal dimension of the channel, so that the separate locking device can be held in the channel by press fit and the separate locking device and/or the lateral locking elements is/are made of a compressible material. However, Pervan discloses connecting means having a separate locking device 52 which can be pushed into a channel formed by the lateral connecting elements 8, 12, is greater than the corresponding internal dimension of the channel, so that the separate locking device can be held in the channel by press fit and the separate locking device consist of a compressible material (Fig 14c), (Par 71, 76). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the connecting elements of Hanning to include a locking device as taught by Pervan in order to counteract changes in the properties of the floor panels caused by moisture (Abstract).

Regarding claim 15, Hanning modified by Eisermann discloses as disclosed in claim 8, but does not disclose the panels are formed as laminate flooring panels including a base board and a decorative layer. However, Pervan discloses panels which are formed in particular as laminate flooring panels comprising a base board and a decorative layer.(Paragraph 67). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the panels of Hanning to be formed as laminate flooring including a base and a decorative layer as taught by Pervan in order to provide a moisture proof material and a decorative appearance.

(10) Response to Argument

Applicant's arguments filed 1/3/2012 have been fully considered but they are not persuasive.

Claim 1,

On page 8 of the brief appellant argues that “the profiled cross-sectional portions 47 and 48 of Hanning do meet the limitation of having the same geometry but inverted with respect to one another”. Examiner wants to note that portions 47 and 48 have the same shape or form which is the same as having the same geometry as can be seen clearly in Figure 8; although the dimensions are slightly different to create the space L1, the portions have the same geometry because they have the same shape and/or form. Furthermore, examiner wants to note that applicant's disclosure does not provide any indication that having the same geometry is equivalent to having the same dimension. Nowhere in the specification can the examiner find any mention of the term dimension.

Claim 3,

On page 10 of the brief appellant argues that “Hanning does not teach that portions 47 and 48 are configured so that they can be connected by lowering and then pushing the connecting means towards each other in a direction perpendicular relative to the lowering motions”. Examiner wants to note that this is an apparatus claim directed towards “connecting means” and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it meets the claim. In this

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case the connecting means are capable of being configured so that they can be connected by lowering and then pushing the connecting means towards each other in a direction perpendicular relative to the lowering motions. Examiner asserts that portions 47 and 48 are certainly connected by lowering and can be pushed towards each other even though there would be only a slight movement or not movement at all, still the connecting means are capable of being pushed. Furthermore, the claims do not include any structural limitations indicating how the pushing of the connecting means towards each other would have the tongue of one portion being received in a groove of the other portion.

Claims 4-7,

On page 12 of the brief appellant argues that there is no teaching, suggestion, or motivation to combine the references modifying Hanning in view of Pervan, stating that there is no reason to include any of the locking devices of Pervan into the connecting means of Hanning. However, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, Hanning was used for the teaching of panels having connecting means that are perpendicular relative to each other and profiled cross sectional portions having the

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same geometry but inverted with respect to one another. Pervan was used for the teaching of separate locking means that counteract changes in the properties of the floor panels due to moisture.

Further, the appellant is drawing conclusions without proof when he states that “the proposed combination would alter the panels of Hanning that they would no longer interconnect in their intended manner”. The appellant is merely drawing his own conclusions as to what the references are teaching. Hanning teaches “spaces 53” that can be used as “glue pockets” (Fig 8), (Col 10, Lines 49-62) indicating that those spaces can be filled without destroying the intended purpose. The examiner contends that including a separate locking device would provide a seal that would counteract changes in the properties of the floor panels due to moisture thus improving the connecting means of Hanning.

Claim 4,

On pages 13-14 of the brief appellant argues that “examiner completely ignores the limitation “after the panel edges have been connected together”. Examiner wants to note that the limitation “after the panel edges have been connected together” is considered a method step and is regarded to as functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP § 2114. Examiner contends that the separate connecting means are capable of being inserted between the panel edges after the panel edges have been connected together.

Claim 6,

On page 16 of the brief appellant argues that “the separate locking means 52 is part of the edge of the panel and it is not a separate locking means which can be pushed into a channel formed between the panel edges”. Examiner asserts that Pervan discloses a separate locking means 52 that can be mechanically applied in solid form in the groove by snapping in or pressing in into undercut grooves or by gluing to the edge of the groove, (Par 76). Thus the separate locking means of the modified connecting means are capable of being pushed into a channel formed between the panel edges.

Claim 17,

On page 17 of the brief appellant argues that Pervan does not disclose a securing pin. Examiner acknowledges that one would consider a pin to have a rounded elongated shape; however, applicant's pin has a rectangular shape as can be seen in Figure 1c of the disclosure. Pervan discloses that the locking means can be formed with different geometries having different angles and radii which can facilitate inward angling and displacement (Par 179). Thus examiner contends that the locking means of Pervan can be considered to be a securing pin in the same manner than applicant's rectangular locking means are considered a "securing pin".

Claims 8 and 16,

On page 18 of the brief appellant argues the combination of Hanning and Eiserman lacks a reasonable basis. Hanning already has a means for locking the panels together, so there simply is no reason to include any of the locking devices of Eiserman. However, the examiner recognizes that obviousness may be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, Eiserman was used for clearly showing the teaching of panels having longitudinal connecting elements that connect with each other by a turning motion as can be seen in Figure 8. Examiner wants to point out that Hanning in Figures 3 and 4 also teaches longitudinal connecting elements similar to the ones of Eiserman in Figures 3 and 4, thus the boards of Hanning would perform in the intended manner.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/ADRIANA FIGUEROA/

Examiner, Art Unit 3633

Conferees:

Application/Control Number: 10/596,992

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/BRIAN GLESSNER/

Supervisory Patent Examiner, Art Unit 3633

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